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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|-------------------|
| 10/615,656 | 07/09/2003 | Takashi Yoshizawa | 763-37 | 9316 |
| 28249 | 7590 | 07/24/2006 | | EXAMINER |
| DILWORTH & BARRESE, LLP 333 EARLE OVINGTON BLVD. UNIONDALE, NY 11553 | | | | MOHANDESI, JILA M |
| | | | ART UNIT | PAPER NUMBER |
| | | | | 3728 |

DATE MAILED: 07/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/615,656 | YOSHIZAWA, TAKASHI | |
| | Examiner | Art Unit | |
| | Jila M. Mohandes | 3728 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on RCE filed 05/03/06.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1,2,4-14,16,17 and 19-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-2 and 4-14, 16-17 and 19-26 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 03, 2006 has been entered.

This application contains claim 3 drawn to an invention nonelected without traverse in Paper filed on 1/31/05. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Accordingly, claims 1-2 and 4-14, 16-17 and 19-26 will be further examined on the merits.

Information Disclosure Statement

2. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-2, 4-14, 16-17 and 19-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, the phrase "and allow contents within the case to be directly retrieved in a single step by the same hand or member depressing the button" is vague, indefinite and inaccurate. It is not clear how in a single step the eye glasses is being retrieved from the case, since the first step would be to open the eye glass case by depressing the button by a hand or member and after the case is open the second step would be to retrieve the eye glass from the case.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1 and 10-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Taormina [6,170,651].

Taormina discloses in Figs 1-2, an eyeglass case 10 comprising: an upper cover [first closed end 26], a lower cover [second closed end 30], a button 46 which is secured to the lower cover and a rotating member [pivot point 50] which is secured to a contact

portion [Fig 1] between the upper cover and the lower cover, wherein said rotating member is arranged such that when pushing the button for release, a spring 52 in the rotating member moves to slowly open the upper cover upwardly away from the lower cover and allow contents within the case to be removed in a single step by the same hand. By pushing on button 52 while tilting the eyeglass case, you can retrieve the eye glasses by the same hand.

Additionally, Taormina discloses a button-securing portion/ upper lock member [opposing ledge 48] situated upon upper cover as recited in claim 10, lower lock member [latch 44] situated upon lower cover as recited in claim 11.

Since the device disclosed in the reference includes all of the structural elements of the claims it is presumed to be inherently capable of all the claimed functions including the ability to be opened with just a single hand by depressing the button and be removed in single step by the same hand.7.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 8-9 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Taormina.

Taormina discloses most of the elements of these claims as stated above but for two rotating members respectively situated on lateral ends of the eyeglass case. It

would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the device of Taormina with a second rotating members in order to have stronger attachment, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art.

St. Regis Paper Co. v. Bemis Co., 193 USPQ 8.

With respect to claim 21, the cylindrical eyeglass case of Taormina is considered to be oblong inasmuch as it deviates from a circle by elongating in one dimension. The rotating member is positioned along one of said longer sides of the eyeglass case, see Figure 2 embodiment which clearly shows the rotating member being positioned along one of said longer sides, and said button positioned adjacent the other of said longer side. Furthermore it has been held that rearranging parts of an invention involves only routine skill in the art. In re Japikse, 86 USPQ 70.

9. Claims 1, 8-12 and 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Watson [6,726,004] in view of Taormina. Watson discloses an eyeglass case comprising; an elongated generally rectangular housing defining an interior space configured and dimensioned to hold a pair of eye glasses and having a lower portion (104) and an upper cover (102) hingedly attached to the lower portion along a lengthwise edge of the lower portion and movable between an open position and a closed position; latch means (magnetic latch) secured to the upper portion, said latch means having upward facing surface and including a member movable between a first position wherein the member is engageable with the cover when the cover is in the closed position and a second position wherein the member is not engageable with the

cover, said member being moved to the second position by biasing force and in response to activation of an activator (lightly pressing downward on the cover by hand) possessing an upward facing activation surface (top surface of the cover) to release contact with the upper cover; biasing means (spring 160) for providing the biasing force and pivoting the cover to open position upon activation of the activator, upwardly and away from the lower portion; and damping means (dampener mechanism 152) for slowing the upward pivoting movement of the cover. Watson does not appear to disclose the specifics of the latch means. However, Watson discloses that the latch may be of any type and may be located in any effective location, see column 4, lines 56-60.

Taormina discloses in Figs 1-2, an eyeglass case 10 comprising: an upper cover [first closed end 26], a lower cover [second closed end 30], a button 46 operated latch means which is secured to the lower cover and a rotating member [pivot point 50] which is secured to a contact portion [Fig 1] between the upper cover and the lower cover, wherein said rotating member is arranged such that when pushing the button for release, a spring 52 in the rotating member moves to slowly open the upper cover upwardly away from the lower cover and allow contents within the case to be removed. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a button activated latch means to the case of Watson as taught by Taormina for easier operation, especially in view of the fact that Watson clearly discloses that any type of latch means can be used.

The shape of the eye glass case appears to be generally rectangular, furthermore, it would have been an obvious matter of design choice to modify the shape

to be more rectangular , since such a modification would have involved a mere change in the shape of a component. A change in shape is generally recognized as being within the level of ordinary skill in the art. *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966).

Watson-Taormina discloses most of the elements of these claims as stated above but for two rotating members respectively situated on lateral ends of the eyeglass case. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the device of Taormina with a second rotating members in order to have stronger attachment, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art.

St. Regis Paper Co. v. Bemis Co., 193 USPQ 8.

With respect to claim 21, the cylindrical eyeglass case of Watson-Taormina is oblong and the rotating member is positioned along one of said longer sides of the eyeglass case.

11. Claims 2, 4-7, 13-14, 16-17, 19-20, 22 and 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Watson-Taormina and further in view of Lin [US 2003/0201265 A1].

Watson-Taormina as described above discloses most of the elements of these claims as stated above. Watson-Taormina does not disclose a support spindle wherein oil is sealed in the support spindle as recited in claim 2, to claim 4, wherein the outer housing is constituted by an outer cylindrical frame with the support spindle structured and arranged to fit into the frame along an inner circumferential wall thereof as recited in

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claim 5. Additionally, Watson-Taormina does not disclose protrusions extending from a lateral end wall of the outer cylindrical frame and inner lateral surface of the support spindle as recited in claim 6, button is situated on the upper cover as recited in claims 9 and 17.

Lin teaches the concept of providing a container to hold items having a pivoting cover 20 with two support spindle [pivot element 30] wherein oil [subsection 0041] is sealed in the support spindle, wherein the outer housing is constituted by an outer cylindrical frame [semi-sleeves 23 and 24] with the support spindle structured and arranged to fit into the frame along an inner circumferential wall thereof, protrusions extending from a lateral end wall of the outer cylindrical frame and inner lateral surface of the support spindle [subsection 0039]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to replace the pivoting connection of device of Watson-Taormina with the slow pivoting connection as taught by Lin in order to reduce the noise while opening and closing the eyeglass case.

With respect to claim 22, oil is positioned throughout an interior of said rotating member (external tube 32, internal tube 31 and spring 33) and about the spring positioned therein, i.e. the oil is between the external tube 32 and internal tube 31, which in turn is about the spring.

Response to Arguments

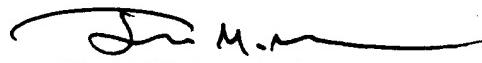
12. Applicant's arguments with respect to claims 1-2 and 4-14, 16-17 and 19-26 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jila M. Mohandes who's telephone number is (571) 272-4558. The examiner can normally be reached on Monday-Friday 7:30-4:00 (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (571) 272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jila M. Mohandes
Primary Examiner
Art Unit 3728

JMM
July 19, 2006